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RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/10/06 has been entered. The examiner will address applicant's arguments at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 17-23,25, with respect to the language "*and data that is replaced as the self controlling robot ages and learns*", the examiner finds this language to be indefinite. The examiner would first like to point out that this language is really directed to the intended use of the system and does not define anything structurally to the system itself; however, it is claim language in totality that must be considered when analyzing the scope of the claims. This language is considered indefinite because. A person wishing to avoid infringement would not know whether or not the claim is infringed by just having the system (2 terminals and server), or if the claim is only

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infringed if one has the claimed system and replaces data as the robot ages and learns.

This is not clear.

For claim 24, the examiner has concluded that the recitations of “a registration step for...” and “a sales step for...” are indefinite. What is the actual step that is being claimed? The way the claim language is written, the registration step is “for providing ID information to a mating center”, but what does this mean? Is this a positive recitation to an actual step of providing the ID information? Does this language have a scope that could allow for the registering step to be satisfied by a person turning on a computer so that they can register information? This would be a step in the process of registering information (because the computer needs to be turned on), so would this satisfy the claimed “registration step for”? The examiner is not clear as to what the scope of the recited steps is. The examiner feels that claiming a step for doing something is not the same as claiming the step of actually doing that something. With respect to “a sales step” for selling the provided ID, can this be the act of advertising the ID information for sale, so that in the future the information can be sold? What is the sales step that is being claimed? Does the step actually require a sale to occur or is the scope of the language “a sales step for” allow for others steps that do not include the actual step of selling? It is not clear what is being claimed.

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 17-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Tornetta (4870576).

For claim 17, Tornetta discloses an online sales system. Tornetta discloses a *first terminal 100* that is used to register or upload information to a *sales server 200*. The sales server 200 is used to store the information received from terminal 100 and for outputting data to a *second terminal (also 100)*. This system allows a seller to upload data to the sales server, and for a buyer to access the data at a 2nd terminal. The *network is 20* in Tornetta. The language “for registering inheritance information associated with one or more robots”, “for purchasinginformation” and “for receivinginformation” is reciting the intended use of the 1st terminal, sales server, and the 2nd terminal and this language is satisfied by Tornetta because the 1st terminal, 2nd terminal, and sales server are all fully capable of registering and receiving the claimed robot type of data. The “robot data” is not positively claimed and is not even part of the system itself. The robot data is only being recited as the kind of data that is intended to be

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registered and sold, etc.. The limitation directed to the inheritance information has been considered but does not change the scope of the claim because all that is structurally claimed is a first and second terminal and a server. The claim is reciting that the intended use of the system is for inheritance information of robots but this recites no further structure to the claimed system so as long as Tornetta is capable of using robot data, which it is, then the claim is anticipated by Tornetta. The examiner notes that it has been previously held that *"A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).* In the instant case Tornetta is fully capable of being used to upload and sell "robot data" as claimed. Tornetta discloses the system as claimed and is capable of being used with robot data as claimed.

For claim 18, the mating means for combining a plurality of pieces of inheritance information is considered to be satisfied by Tornetta. This is because Tornetta discloses in column 8, lines 23-31 that a file is created that lists the serial numbers of properties that satisfy the search criteria. This file is made by combining a plurality of pieces of data (serial numbers) into one file. Information from separate files is merged into one file, which satisfies what is claimed.

For claims 18-21, with respect to the recitations about what kind of purchase is happening and what the inheritance information is, they are the intended use of the system and are satisfied by the fact that Tornetta is capable of being used with robot data as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For claim 22, the sales server 200 accepts data from and can transmit data to terminals 100 as claimed. The claimed means has a recited function of “for presenting registered inheritance information to said first terminal and said second terminal”, and Tornetta is fully capable of and does present information as claimed.

For claim 23, the memory means is satisfied by the fact that Tornetta discloses that information is stored on a database by sales server 200. A database is a means to store information. As stated previously the type of data will not receive patentable weight because it is considered as non-functional descriptive material directed to the intended use of the system (i.e. the kind of data the system is intended to hold and display to users).

For claim 24, Tornetta discloses a sales method as claimed. Tornetta discloses a method by which a seller can register information on a property and a buyer can

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search for properties to buy. The registration step is satisfied by the seller in Tornetta registering their information and having it stored by the sales server 200. ID information is inherent to Tornetta because the system necessarily includes data that identifies the persons who are registering information. Applicant should take notice that the recited "a registration step" in the opinion of the examiner is not even actually reciting the registration of anything. Turning on a computer that a person is going to use to register data appears to satisfy what is claimed because this is a step in a process with the intent being for the registration of data. The "registration step" is for registering information, but it is not positively claimed that any registration is even taking place. This step can arguably be satisfied by anything. The sales step is interpreted to be the step of a buyer receiving results from the inputted search criteria or alternatively can be considered satisfied by the seller uploading their data to the server. Both acts of receiving results and uploading of seller data are for the intended purpose of affecting a sale. As stated for the registration step, the sales step is not positively reciting the sale of anything. With respect to the recitations that the data is inheritance information for robots, this is considered to be simply a recitation of the kind of data that is intended to be registered or sold and is satisfied by the fact that Tornetta can be used with robot data. As stated previously, the recited steps are not actually reciting the registration or sale of anything at all and no data is being used in any manipulative manner. Unless the data is being manipulated in some manner or used in some useful manner, this is just considered to be non-functional descriptive material that does not serve as a limitation (even if it were actually claimed). Because applicant has not claimed anything

that requires the data to be actually registered or sold the data is not even part of the scope of the method.

For claim 25, Tornetta discloses a sales server as claimed. The registration means is interpreted to be the software/hardware that saves data to the database of the sales means 200. The server of Tornetta is capable of being used with robot data and can be used in the intended use manner as recited by applicant. All that is claimed is a registration means and a sales means, with the intended use of these means being for use with robot data.

5. Claim 17,19-23,25, are rejected under 35 U.S.C. 102(e) as being anticipated by Gabai et al. (6160986). Gabai discloses an online system for the downloading of robot personality type data. See col. 11, lines 8-20. The 1st terminal is considered inherent to Gabai because the robot data saved on the remote server has to get on the server by a 1st terminal (it has to be put on the server and saved initially, this is necessarily 100% present) so that the 2nd terminal 60 can download the data from the server. A network is inherent in Gabai because a network is necessary to be able to download the data. You cannot download the data without a network. With respect to the intended use of the device such as it being for a "sale" of data, describing a type of purchase, and for storing specific type of data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (which in the instant case Gabai is

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fully capable of the intended use limitations) then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The newly added limitation directed to the inheritance information and data that is replaced has been considered but does not change the scope of the claim because all that is structurally claimed is a first and second terminal and a server. The claim is reciting that the intended use of the system is for inheritance information of robots but this recites no further structure to the claimed system.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadakuni (6594649).

For claims 17,18,20,21,23,25, Sadakuni discloses a robot device that has personality data downloaded into the device from an external device such as a remote computer (registration means of claim 25). In column 13, lines 1-32, Sadakuni discloses that robot personality data can be downloaded (to a 2nd terminal) to the robot device from the Internet (Internet is the sales means of claim 25). Sadakuni discloses

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that by having the ability to get data from the Internet, data from multiple devices can be cross bred (mating means) to create a new system with a new personality. This cross breeding inherently requires uploading of robot data from a 1st terminal to make the data available via the Internet so it can be cross bred (to replace previous robot data). A network is inherent in Sadakuni because a network is necessary to be able to download the data. Sadakuni does not disclose a "server". It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a server in the system of Sadakuni so that the robot data can be stored and accessed via the Internet. The use of a server to manage and store data on the Internet is very well known and would have been obvious to one of ordinary skill in the art just based on the skill level of one of ordinary skill in the art. The use of a "server" is considered to be something that is within the collection of knowledge that one of ordinary skill in the art would be in possession of. With respect to the intended use of the device such as it being for a "sale" of data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (which in the instant case is fully capable of the intended use limitations) then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The newly added limitation directed to the inheritance information has been considered but does not change the scope of the claim because all that is

structurally claimed is a first and second terminal and a server. The claim is reciting that the intended use of the system is for inheritance information of robots but this recites no further structure to the claimed system.

For claim 19, Sadakuni discloses a recordable medium in column 13.

For claim 22, the registration means is considered to be present in Sadakuni.

For claim 24, Sadakuni discloses the invention substantially as claimed.

Sadakuni discloses that robot personality data can be stored for downloading on/from the Internet. This satisfies the claimed registration step of registering inheritance information on-line. Sadakuni does not disclose the "selling" of the robot personality data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sell the robot data so that one can make money. Prior to the filing date of this application it was in the public domain that various companies are selling robots for personal use where the robots possess a personality determined by personality data. In view of this fact and in view of the fact that one can find just about everything for sale nowadays the concept of "selling" robot personality data (noting that robots that use the data are already being sold in the retail marketplace) is considered obvious to one of ordinary skill in the art.

8. Applicant's arguments filed 4/10/06 have been fully considered but they are not persuasive. The examiner has considered applicant's most recent response and it is found to be non-persuasive.

With respect to the 112,2nd paragraph rejection to claim 24, applicant still has not amended the claim language at issue to overcome the rejection and has not provided any kind of traversal on the merits. The rejection will be maintained and the position of the examiner has not changed with respect to this claim due to the language “a step for”. The claim is indefinite and no persuasive argument has been presented that overcomes the rejection.

With respect to the Tornetta reference, the Gabai reference, and the Sadakuni reference, applicant has argued that the language in the claims defining the kind of robot data claimed is not found in the prior art. *With respect to the article claims, the position of the examiner is that the robot data is only claimed as the intended use of the system and the “robot data” limitations define no further structure to the system itself, so the argument is non-persuasive.* As stated previously, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to method claim 24, the examiner views the scope of the claim as not positively reciting that information is registered or actually sold. The language of “a sales step for selling....” is not actually claiming the sale of anything. All that this recites is an unknown step that has the intended purpose of selling. One can view a sales step

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as any act that may take place to cause a sale to be achieved. The same is true for the “registering step for registering” limitation. Because it is not actually claimed that the data is being used in the method, no patentable weight will be given to the kind of data recited. If you do not actually register the data, it does not exist and is not present in the scope of the claim. Additionally, even if the data is positively recited as being registered and sold, is applicant going to argue that the claim is novel because of the type of data that is being registered and sold? Data has clearly been registered and sold in the world we live in today much prior to the filing date of the instant application, so why would the kind of data that is being sold result in a patentable invention? If the kind of data would render a sales method claim patentable, one could arguably claim the registering and selling of data that comprises their name, dogs name, age, favorite food, and you could then get a patent on a method directed to registering and selling this data. The argument directed to the newly added limitation is non-persuasive.

With respect to the 103 rejection in view of Sadakuni, the examiner notes that applicant has not traversed the obviousness statement of the rejection concerning the obviousness of using/providing a “server”. The obviousness statement itself is deemed proper. Applicant has argued that claimed kind of robot data (intended use of the article or system) for patentability, which is found to be non-persuasive as previously addressed by the examiner.

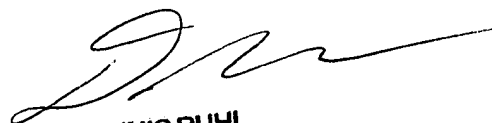
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808.

The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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